

REMARKS

Claims 4-20, 23, 25-28, 30-38, 44, and 45 are pending. By this Amendment, Claims 23, 25-28, and 30-38 are cancelled, thereby leaving Claims 4-20, 44, and 45 unchanged.

Claims 4, 6-8, 10, 11, and 15-20

Claims 4, 7, and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,662,562 ("Lindell"). Also, Claims 4, 6-8, 10, and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lindell in view of U.S. Patent No. 3,043,616 ("Magnuson") or U.S. Patent No. 3,811,747 ("Levin"). In addition, Claims 4, 17, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morimoto in view of Lindell.

Independent Claim 4 recites (*italics added for emphasis*):

A saw comprising:
a housing;
a motor supported by the housing and operable to drive a saw blade;
a cover selectively connectable to the housing, the cover at least partially covering the saw blade when the cover is connected to the housing; and
a quick-locking member connected to one of the housing and the cover and engageable with the other of the housing and the cover to selectively lock the cover to the housing without the use of tools;
wherein the quick-locking member is connected to the housing and is engageable with the cover;
wherein the quick-locking member has a first position, in which the quick-locking member engages the cover to lock the cover to the housing, and a second position, in which the quick-locking member is disengaged from the cover and the cover is not locked to the housing;
wherein the quick-locking member is pivotable between the first position and the second position.

Lindell discloses a hand drill 7, which can have a saw attachment connected thereto. The drill 7 includes a housing (not identified with a reference number, but in the vicinity of reference number 7 in Fig. 1) and a motor (not shown) supported within the housing. The saw attachment includes a drive shaft 24 having a first end coupled to the motor of the drill and a second end displaced a significant distance from the first end and coupled to a saw 36. The drive shaft 24 is driveable by the motor of the hand drill 7 to turn the saw 36 for cutting purposes. A shaft casing 12 cases the drive shaft 24 and has a pair of guide plates 44 connected to an end of the shaft

casing distal the hand drill 7. With reference to Figs. 8-14 of Lindell, the saw attachment includes a guard for the saw 36. The saw guard includes a receptacle 54 connected to a front member 28 adjacent the distal end of the shaft casing 12 for collecting saw dust. The saw guard also includes a cover 55 attached to the receptacle 54.

Lindell does not teach or suggest a saw comprising a motor supported by a housing, a cover selectively connectable to the housing, and a quick-locking member connected to the housing. Rather, Lindell discloses a motor (of the drill) connected to a housing of the drill, a cover 55 connected to a receptacle of a saw guard, and a screw stud 58 and nut 59 connected to the cover 55. The drill housing and the saw guard are clearly separate items. The Examiner attempts to rely on a variety of objects, particularly the drill housing, the shaft casing 12, the base housing 21, and the receptacle 54 of the saw guard, to satisfy the “housing” claimed in claim 4. This is clearly improper.

Also, Lindell does not teach or suggest, among other things, a quick-locking member being pivotable between a first position and a second position. The Examiner provides conflicting statements with regards to this claimed limitation. Particularly, the Examiner first attempts to reject this limitation under 35 U.S.C. §102(b) in view of Lindell (see Office action dated August 16, 2005, page 3, lines 1-3), then, the Examiner states that “to the degree that it could be argued that the quick-locking member does not pivot from a first position to a second position in Lindell, the rejection below is provided.” See Office action dated August 16, 2005, page 4, ¶5. The “rejection below” reference by the Examiner relates to a 35 U.S.C. §103(a) rejection with Lindell in view of Levin or Magnuson. These conflicting statements clearly show the Examiner’s doubt that Lindell discloses a quick-locking member pivotable between a first position and a second position. Applicants agree that Lindell does not teach or suggest a quick-locking member pivotable between a first position and a second position. Appropriately, the 35 U.S.C. §102(b) rejection should be withdrawn. Regarding the 35 U.S.C. §103(a) rejection, for the sake of brevity, reference is made to the discussion above relating to the Examiner’s lack of establishing a *prima facie* case of obvious.

For these and other reasons, Lindell does not teach or suggest the subject matter of independent Claim 4.

Morimoto does not cure the deficiencies of Lindell. Morimoto discloses a rotary saw 1, two discs, a motor 3, a casing for containing the motor 3, a table 5, and a dust collecting device 8.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of presenting a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. In re Vaeck, 947 F.2d 488, 493, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. Id. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§706.02(j), 2143.03.

Morimoto does not teach or suggest, among other things, a quick-locking member connected to the housing that is engageable with a cover. Therefore, Morimoto cannot teach or suggest a quick-locking member pivotable between a first position and a second position.

Assuming *arguendo* that Lindell and Morimoto could be combined, they do not teach or suggest all the claim limitations of Claim 4. For these and other reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 4 based upon the prior art as required by 35 U.S.C. §103. Accordingly, independent claim 4 is allowable. Claims 6-8, 10, 11, and 15-20 depend from independent claim 4 and are allowable for the same and other reasons.

Independent Claim 5

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Lindell in view of Levin or Magnuson.

Independent Claim 5 recites (*italics added for emphasis*):

A saw comprising:
a housing;
a motor supported by the housing and operable to drive a saw
blade;
a cover selectively connectable to the housing, the cover at least
partially covering the saw blade when the cover is connected to the housing;
a quick-locking member connected to one of the housing and the
cover and engageable with the other of the housing and the cover to selectively
lock the cover to the housing without the use of tools;

wherein *the quick-locking member is connected to the housing and is engageable with the cover;*

wherein the quick-locking member has a first position, in which the quick-locking member engages the cover to lock the cover to the housing, and a second position, in which the quick-locking member is disengaged from the cover and the cover is not locked to the housing; and

a spring engageable with the quick-locking member to releasably retain the quick-locking member in the first position.

Lindell does not teach or suggest a saw comprising a motor supported by a housing, a cover selectively connectable to the housing, and a quick-locking member connected to the housing. Rather, Lindell discloses a motor (of the drill) connected to a housing of the drill, a cover 55 connected to a receptacle of a saw guard, and a screw stud 58 and nut 59 connected to the cover 55. The drill housing and the saw guard are clearly separate items. The Examiner attempts to rely on a variety of objects, particularly the drill housing, the shaft casing 12, the base housing 21, and the receptacle 54 of the saw guard, to satisfy the “housing” claimed in claim 5. This is clearly improper.

In addition Lindell does not teach or suggest, among other things, a spring engageable with the quick-locking member to releasably retain the quick-locking member in the first position. No reference to a spring exists in Lindell.

For these and other reasons, Lindell does not teach or suggest the subject matter of independent Claim 5.

Levin does not cure the deficiencies of Lindell. Levin discloses a transit case having a plurality of latches.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of presenting a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

As mentioned above, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. In re Vaeck, 947 F.2d 488; 493, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. Id. Third, the prior art reference (or references when combined) must teach or suggest all of the claim

limitations. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§706.02(j), 2143.03.

There is no suggestion or motivation, whether explicit or implicit, that the teachings of the references should or could be combined. The references are devoid of any teaching or suggestion of the claimed saw and any advantages that flow therefrom. The only motivation for the claimed saw comes from Applicants' invention, and, therefore, the Examiner's rejection is a classic case of hindsight.

The Examiner must find analogous art in order to rely on the art as a basis for rejection. To be analogous, the reference must either be in the field of Applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. Applicants respectfully submit that Levin is non-analogous prior art.

First, Levin is not in the Applicants' field of endeavor. Levin relates to the art of cabinet structures and discloses a stackable transit case. Levin is not related to saws.

In addition, Levin is classified in a different PTO classification than Lindell and the Present Application. Levin is classified in class 312, subclass 308, related to cabinet structures that are removably supportable on top of each other. Lindell is classified in class 30, subclass 331, related to cutlery with a work engaging member. The claimed invention of the Present Application has been preliminarily classified in class 30. The PTO classification of Levin is very different than the classifications of Lindell and the claimed invention of the Present Application. Levin is clearly not in the Applicants' field of endeavor.

Second, Levin is not reasonably pertinent to the particular problem with which Applicants were concerned. A reference may be reasonably pertinent if it is one which logically would have commended itself to an inventor's attention in considering his problem. A person of ordinary skill in the art of saws would not reasonably be expected or motivated to look to the art of cabinet structures to solve the problems of saws. Applicants would have had less motivation or occasion to consider Levin because the reference is directed to a different purpose. The Examiner has combined the disparate elements from Lindell and Levin with the benefit of improper hindsight, and the combination is insufficient to present a *prima facie* case of obviousness. For these and other reasons, Levin is non-analogous prior art and is not an appropriate basis for a rejection under 35 U.S.C. §103.

Magnuson also does not cure the deficiencies of Lindell. Magnuson discloses a fastener for fastening a container.

As described above, the Examiner bears the burden of presenting a *prima facie* case of obviousness based upon the prior art and to establish a *prima facie* case of obviousness, all three basic criteria must be met.

There is no suggestion or motivation, whether explicit or implicit, that the teachings of the references should or could be combined. The references are devoid of any teaching or suggestion of the claimed saw and any advantages that flow therefrom. The only motivation for the claimed saw comes from Applicants' invention, and, therefore, the Examiner's rejection is a classic case of hindsight.

The Examiner must find analogous art in order to rely on the art as a basis for rejection. To be analogous, the reference must either be in the field of Applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. Applicants respectfully submit that Magnuson is non-analogous prior art.

First, Magnuson is not in the Applicants' field of endeavor. Magnuson relates to the art of container fasteners and discloses a draw or toggle bolt for fastening together a hinged cover and a container. Magnuson is not related to saws.

In addition, Magnuson is classified in a different PTO classification than Lindell and the Present Application. Magnuson is classified in class 292, subclass 3, related to multiple fasteners for containers. Lindell is classified in class 30, subclass 331, related to cutlery with a work engaging member. The claimed invention of the Present Application has been preliminarily classified in class 30. The PTO classification of Magnuson is very different than the classifications of Lindell and the claimed invention of the Present Application. Magnuson is clearly not in the Applicants' field of endeavor.

Second, Magnuson is not reasonably pertinent to the particular problem with which Applicants were concerned. A reference may be reasonably pertinent if it is one which logically would have commended itself to an inventor's attention in considering his problem. A person of ordinary skill in the art of saws would not reasonably be expected or motivated to look to the art of container fasteners to solve the problems of saws. Applicants would have had less motivation or occasion to consider Magnuson because the reference is directed to a different purpose. The Examiner has combined the disparate elements from Lindell and Magnuson with the benefit of improper hindsight, and the combination is insufficient to present a *prima facie* case of obviousness. For these and other reasons, Magnuson is non-analogous prior art and is not an appropriate basis for a rejection under 35 U.S.C. §103.

Lindell and Levin or Magnuson, alone or in combination, do not teach or suggest the subject matter of independent Claim 5. In addition, Levin and Magnuson are non-analogous prior art, and there is no suggestion or motivation to combine the teachings of Lindell and Levin or Magnuson. For these and other reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 5 based upon the prior art as required by 35 U.S.C. §103. Accordingly, independent claim 5 is allowable.

Independent Claim 9

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Lindell in view of Levin or Magnuson.

Independent Claim 9 recites (*italics added for emphasis*):

A saw comprising:
a housing;
a *motor supported by the housing* and operable to drive a saw blade;
a *cover selectively connectable to the housing*, the cover at least partially covering the saw blade when the cover is connected to the housing; and
a quick-locking member connected to one of the housing and the cover and engageable with the other of the housing and the cover to selectively lock the cover to the housing without the use of tools;
wherein the *quick-locking member includes an over-center biasing latch*.

Lindell does not teach or suggest a saw comprising a motor supported by a housing and a cover selectively connectable to the housing. Rather, Lindell discloses a motor (of the drill) connected to a housing of the drill and a cover 55 connected to a receptacle of a saw guard. The drill housing and the saw guard are clearly separate items. The Examiner attempts to rely on a variety of objects, particularly the drill housing, the shaft casing 12, the base housing 21, and the receptacle 54 of the saw guard, to satisfy the “housing” claimed in claim 9. This is clearly improper.

In addition, Lindell does not teach or suggest, among other things, a quick-locking member including an over-center biasing latch. No reference to an over-center biasing latch exists in Lindell.

For these and other reasons, Lindell does not teach or suggest the subject matter of independent Claim 9.

Neither Levin nor Magnuson cure the deficiencies of Lindell. Levin discloses a transit case having a plurality of latches and Magnuson discloses a container fastener.

For the sake of brevity, reference is made to the discussion above relating to the Examiner's lack of establishing a *prima facie* case of obviousness with Lindell and Levin or Magnuson. Such discussion is applicable to independent Claim 9 and illustrates that the Examiner has failed to establish a *prima facie* case of obviousness with Lindell and Levin or Magnuson for independent claim 9.

Accordingly, Lindell and Levin or Magnuson, alone or in combination, do not teach or suggest the subject matter of independent Claim 9. In addition, Levin and Magnuson are non-analogous prior art, and there is no suggestion or motivation to combine the teachings of Lindell and Levin or Magnuson. For these and other reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 9 based upon the prior art as required by 35 U.S.C. §103. Accordingly, independent claim 9 is allowable.

Claim 12-14

Claims 12-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lindell in view of Levin or Magnuson.

Independent Claim 12 recites (italics added for emphasis):

A saw comprising:
a housing;
a *motor supported by the housing* and operable to drive a saw blade;
a *cover selectively connectable to the housing*, the cover at least partially covering the saw blade when the cover is connected to the housing; and
a quick-locking member connected to one of the housing and the cover and engageable with the other of the housing and the cover to selectively lock the cover to the housing without the use of tools;
wherein the housing includes a *hook member*, the *cover engaging the hook member at a first end of the cover* and the *quick-locking member engaging the cover at a second end of the cover to connect the cover to the housing*.

Lindell does not teach or suggest a saw comprising a motor supported by a housing and a cover selectively connectable to the housing. Rather, Lindell discloses a motor (of the drill) connected to a housing of the drill and a cover 55 connected to a receptacle of a saw guard. The

drill housing and the saw guard are clearly separate items. The Examiner attempts to rely on a variety of objects, particularly the drill housing, the shaft casing 12, the base housing 21, and the receptacle 54 of the saw guard, to satisfy the “housing” claimed in claim 9. This is clearly improper.

In addition, Lindell does not teach or suggest, among other things, a hook member and a cover engaging the hook member at a first end of the cover and the quick-locking member engaging the cover at a second end of the cover to connect the cover to the housing. Nowhere in Lindell are a hook member and such a cover engagement disclosed.

For these and other reasons, Lindell does not teach or suggest the subject matter of independent Claim 12.

Neither Levin nor Magnuson cure the deficiencies of Lindell. Levin discloses a transit case having a plurality of latches and Magnuson discloses a container fastener.

For the sake of brevity, reference is made to the discussion above relating to the Examiner’s lack of establishing a *prima facie* case of obviousness with Lindell and Levin or Magnuson. Such discussion is applicable to independent Claim 12 and illustrates that the Examiner has failed to establish a *prima facie* case of obviousness with Lindell and Levin or Magnuson for independent Claim 12.

In addition to such discussion above relating to the Examiner’s lack of establishing a *prima facie* case of obvious, Applicants also submit that such lack of establishing a *prima facie* case of obviousness is bolstered by Levin and Magnuson not disclosing a hook member or a cover engaging the hook member at a first end of the cover and a quick-locking member engaging the cover at a second end of the cover to connect the cover to the housing.

The Examiner attempts to rely on Levin (Figs. 11A-11C) to teach such a hook member and cover engagement. Applicants respectfully submit that Examiner has not properly interpreted the disclosure of Levin in Figs. 11A-11C. Particularly, with reference to Levin, the Examiner identifies reference number 1 as the claimed housing, number 69 as the claimed hook member and number 2 as the claimed cover, then proceeds to recite the cover 2 engaging the hook member 69 at a first end of the cover 2 and the quick-locking member engaging the cover 2 at a second end of the cover 2 to connect the cover 2 to the housing 1. Assuming *arguendo* that the reference number 69 is the claimed hook member, the reference number 2 is the cover, and the hook member 69 engages the cover 2 at a first end of cover 2, no quick-locking member engages the cover 2 at a second end thereof. In fact, with reference to Fig. 1, it can clearly be

seen that nothing engages the cover 2 at the second end thereof (see right side of the transit case in Fig. 1).

Accordingly, Lindell and Levin or Magnuson, alone or in combination, do not teach or suggest the subject matter of independent Claim 12. In addition, Levin and Magnuson are non-analogous prior art, and there is no suggestion or motivation to combine the teachings of Lindell and Levin or Magnuson. For these and other reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 12 based upon the prior art as required by 35 U.S.C. §103. Accordingly, independent Claim 12 is allowable. Claims 13 and 14 depend from independent Claim 12 and are allowable for the same and other reasons as independent Claim 12.

Independent Claim 44

Claim 44 stands rejected under 35 U.S.C. §102(b) as being anticipated by Lindell.

Independent Claim 44 recites (*italics added for emphasis*):

A saw comprising:
a housing;
a *motor supported by the housing* and operable to drive a saw blade;
a *cover selectively connectable to the housing*, the cover at least partially covering the saw blade when the cover is connected to the housing; and
a quick-locking member connected to one of the housing and the cover and engageable with the other of the housing and the cover to selectively lock the cover to the housing without the use of tools, the *quick-locking member being pivotable between a first position*, in which the cover is locked to the housing, *and a second position*, in which the cover is not locked to the housing.

Lindell does not teach or suggest, among other things, a saw comprising a motor supported by a housing and a cover selectively connectable to the housing. Rather, Lindell discloses a motor (of the drill) connected to a housing of the drill and a cover 55 connected to a receptacle of a saw guard. The drill housing and the saw guard are clearly separate items. The Examiner attempts to rely on a variety of objects, particularly the drill housing, the shaft casing 12, the base housing 21, and the receptacle 54 of the saw guard, to satisfy the “housing” claimed in claim 44. This is clearly improper.

In addition, Lindell does not disclose a quick-locking member being pivotable between a first position and a second position. The Examiner provides conflicting statements with regards

to this claimed limitation. Particularly, the Examiner first attempts to reject this limitation under 35 U.S.C. §102(b) in view of Lindell (see Office action dated August 16, 2005, page 3, lines 1-3), then, the Examiner states that “to the degree that it could be argued that the quick-locking member does not pivot from a first position to a second position in Lindell, the rejection below is provided.” See Office action dated August 16, 2005, page 4, ¶5. The “rejection below” reference by the Examiner relates to a 35 U.S.C. §103(a) rejection with Lindell in view of Levin or Magnuson. These conflicting statements clearly show the Examiner’s doubt that Lindell discloses a quick-locking member pivotable between a first position and a second position. Applicants agree that Lindell does not teach or suggest a quick-locking member pivotable between a first position and a second position. Appropriately, the 35 U.S.C. §102(b) rejection should be withdrawn. Regarding the 35 U.S.C. §103(a) rejection, for the sake of brevity, reference is made to the discussion above relating to the Examiner’s lack of establishing a *prima facie* case of obvious.

For these and other reasons, Lindell does not teach or suggest all the limitations of independent Claim 44. Accordingly, independent claim 44 is allowable.

Independent Claim 45

Independent Claim 45 recites (*italics added for emphasis*):

A saw comprising:
a housing;
a motor supported by the housing and operable to drive a saw blade;
a cover selectively connectable to the housing, the cover at least partially covering the saw blade when the cover is connected to the housing;
a quick-locking member connected to one of the housing and the cover and engageable with the other of the housing and the cover to selectively lock the cover to the housing without the use of tools, the quick-locking member being movable between a first position, in which the cover is locked to the housing, and a second position, in which the cover is not locked to the housing; and
a spring engagable with the quick-locking member to releasably retain the quick-locking member in the first position.

Lindell does not teach or suggest, among other things, a saw comprising a motor supported by a housing and a cover selectively connectable to the housing. Rather, Lindell discloses a motor (of the drill) connected to a housing of the drill and a cover 55 connected to a receptacle of a saw guard. The drill housing and the saw guard are clearly separate items. The

Examiner attempts to rely on a variety of objects, particularly the drill housing, the shaft casing 12, the base housing 21, and the receptacle 54 of the saw guard, to satisfy the “housing” claimed in claim 45. This is clearly improper.

In addition, Lindell does not teach or suggest, among other things, a spring engagable with the quick-locking member to releasably retain the quick-locking member in the first position. No reference to a spring exists in Lindell.

For these and other reasons, Lindell does not teach or suggest the subject matter of independent Claim 45.

Neither Levin nor Magnuson cure the deficiencies of Lindell. Levin discloses a transit case having a plurality of latches and Magnuson discloses a container fastener.

For the sake of brevity, reference is made to the discussion above relating to the Examiner’s lack of establishing a *prima facie* case of obviousness with Lindell and Levin or Magnuson. Such discussion is applicable to independent Claim 45 and illustrates that the Examiner has failed to establish a *prima facie* case of obviousness with Lindell and Levin or Magnuson for independent claim 45.

Accordingly, Lindell and Levin or Magnuson, alone or in combination, do not teach or suggest the subject matter of independent Claim 45. In addition, Levin and Magnuson are non-analogous prior art, and there is no suggestion or motivation to combine the teachings of Lindell and Levin or Magnuson. For these and other reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 45 based upon the prior art as required by 35 U.S.C. §103. Accordingly, independent claim 45 is allowable.

CONCLUSION

In view of the foregoing, entry of the present Amendment and allowance of Claims 4-20, 44, and 45 are respectfully requested.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,


Paul M. McGinley
Reg. No. 55,443

Docket No. 066042-9415-01
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Suite 3300
Milwaukee, Wisconsin 53202-4108
(312) 222-0800